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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,037	03/19/2001	Ian E. Smith	D/A0458	9334

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/812,037

Applicant(s)

SMITH ET AL.

Examiner

Brian Goddard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 4-10, 12-18 and 20-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,101,506 to Ukai et al.

Referring to claim 1, Ukai discloses a system and method for organizing a plurality of objects as claimed. See Figures 1-10 and the corresponding portions of Ukai's specification for this disclosure (Refer also to Ukai's claims 1-5). In particular, Ukai teaches "a method of organizing a plurality of objects [files], comprising the steps of:

selecting a first [new file: See Figures 8-9] and second [latest version file: See Figure 10] object [file] from the plurality of objects [Also see column 2, lines 9-55];

creating [See Figures 8-10] a group [file-case: 'file group' or 'group of files'] from the first and second objects [Also see column 2, lines 9-55];

designating [Step 1055 (See column 8, lines 11-29; column 2, line 21 – column 3, line 8; and column 23, lines 24-38)] one of the selected objects [example: Hitachi

Catalog Vol. 5] as a representative [representative image (116) on file-case door (113)] of the group [example: Hitachi Catalog]; and,

displaying [See Figures 1-2, 7 and 9] the representative of the group with the plurality of objects" as claimed.

Referring to claim 2, Ukai discloses the method exactly as claimed. See the Background and Summary of the Invention sections, as well as Figures 1-4 and the corresponding portions of Ukai's specification for this disclosure. In the broadest reasonable interpretation of the claim, Ukai teaches that "an object [a particular photograph (file) for example (See column 1, lines 36-46)] may be part of more than one group [may be in both a catalog and an album, or even in two different catalogs for example (See Figures 1-4)]" as claimed. In a more specific interpretation of the claim, Ukai teaches that "an object [Hitachi Catalog Vol. 3] may be part of [linked into (35)] more than one group [Hitachi Catalog and Hitachi Catalog 2]" as claimed. See Figure 4 and the corresponding portion of Ukai's specification for this disclosure. Regardless of which interpretation is taken, Ukai discloses the invention exactly as claimed.

Referring to claim 4, Ukai discloses the method exactly as claimed. See Figures 1-2, 7 & 9 and the corresponding portions of Ukai's specification for this disclosure. Ukai's step of displaying the representative of the group "further includes not displaying the other objects of the group [See Figures 1 & 2: only the representative image 116 is displayed for each group 112], and indicating [by file-case knob (114)] that the object being displayed is a representative of the group [See Figures 1 & 7]" as claimed.

Referring to claim 5, Ukai discloses the method exactly as claimed. See Figure 10 and the corresponding portion of Ukai's specification for this disclosure. Ukai's method further includes the steps of: "detecting [Step 1010] a third object [newer version of a file]; and, adding [Steps 1015 – 1070 (remainder of method 1000)] the third object to the group, responsive to the detecting step" as claimed.

Referring to claim 6, Ukai discloses the method exactly as claimed. See Figures 1 & 7 and the corresponding portions of Ukai's specification for this disclosure. In particular, Ukai teaches that "the objects of the group may be viewed [Figures 7B & 7C] by selecting the representative [Figure 7A]" as claimed.

Referring to claim 7, Ukai discloses the method exactly as claimed. See Figures 10, 15 & 17-18 and the corresponding portions of Ukai's specification for this disclosure. Refer specifically to the final step of Ukai's claim 1 where Ukai teaches that "the representative of the group may be changed ['when the file group is updated, changing and displaying said representative image']" as claimed.

Referring to claim 8, Ukai discloses the method exactly as claimed. See Figures 20-21 and the corresponding portions of Ukai's specification for this disclosure. In particular, Ukai teaches the method of claim 1, as above, "wherein the objects of the group will be treated as a single object [representative file (e.g. Hitachi Catalog Vol. 5)] such that when a search is performed on the plurality of objects [Search Range: All Files] the representative will be returned [See Figure 21] if any of the objects of the group meet a search parameter [e.g. File Name (including) Catalog]" as claimed.

Claim 9 is rejected on the same basis as claim 1 above. In particular, Ukai teaches “an article of manufacture [computer system of Fig. 1] including an information storage medium [Main Storage 50] wherein is stored information for programming a computer [Rack Managing Program 500] to perform a method of organizing a plurality of objects, the method comprising the steps of...[See claim 1 above]” as claimed.

Claim 10 is rejected on the same basis as claim 2 above, in light of the basis for claim 9. See the discussions regarding claims 2 and 9 above for the details of this disclosure.

Claims 12-14 are rejected on the same basis as claims 4-6 respectively, in light of the basis for claim 9 above. See the discussions regarding claims 4-6 and 9 above for the details of this disclosure.

Claim 15 is rejected on the same basis as claim 8 above, in light of the basis for claim 9. See the discussions regarding claims 8 and 9 above for the details of this disclosure.

Claim 16 is rejected on the same basis as claim 7 above, in light of the basis for claim 9. See the discussions regarding claims 7 and 9 above for the details of this disclosure.

Claim 17 is rejected on the same basis as claim 1 above. In particular, Ukai teaches “an apparatus [See Fig. 1] for organizing a plurality of objects, comprising:

a processor [CPU 10];

a display device [Display Unit 100] in communication with the processor; and,

a processor readable storage medium [Main Storage 50] in communication with the processor, containing process readable program code [Rack Managing Program 500] for programming the apparatus to perform...[See claim 1 above]" as claimed.

Claim 18 is rejected on the same basis as claim 2 above, in light of the basis for claim 17. See the discussions regarding claims 2 and 17 above for the details of this disclosure.

Claims 20-22 are rejected on the same basis as claims 4-6 respectively, in light of the basis for claim 17 above. See the discussions regarding claims 4-6 and 17 for the details of this disclosure.

Claim 23 is rejected on the same basis as claim 8 above, in light of the basis for claim 17. See the discussions regarding claims 8 and 17 above for the details of this disclosure.

Claim 24 is rejected on the same basis as claim 7 above, in light of the basis for claim 17. See the discussions regarding claims 7 and 17 above for the details of this disclosure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukai (U.S. 6,101,506).

Referring to claim 3, the system and method of Ukai as described above with regard to claim 1 discloses the invention as claimed. In Ukai's preferred implementation, the representative image is designated automatically as the most recent (newest) version (volume, issue, etc.) or the most recently accessed version of the file (object). Ukai is silent on whether or not this is "the first object selected during the step of selecting first and second objects" as claimed. However, Ukai does disclose that the user has the ability to designate the representative image as well. See column 2, line 56 – column 3, line 8 for this disclosure. Thus, the user is free to choose whichever file (including the first file selected) he or she wishes to represent the group. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to designate the first object selected in the step of selecting first



and second objects of claim 1 above as the representative object because the user is free to choose this object as the designated object, as disclosed by Ukai.

Claims 11 and 19 are rejected on the same basis as claim 3, in light of the basis for claims 9 and 17 respectively. See the discussions regarding claims 3, 9 and 17 above for the details of this disclosure.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,513,035 to Tanaka et al. is considered particularly pertinent to applicants' claimed invention, and specifically to claims 1 and 8.

U.S. Patent Nos. 5,831,617 to Bhukhanwala; 6,393,427 to Vu et al; 6,522,330 to Kobayashi; and 5,995,978 to Cullen et al. are each considered particularly pertinent to applicants' claimed invention.

The remaining U.S. Patents made of record are considered pertinent to applicants' disclosure, and/or portions of the claimed invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bdg  
April 17, 2003



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